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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,074	07/10/2003	Scott E. Preece	CS22227RA	3394
22917	7590	11/17/2005	EXAMINER	
MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196			CUMMING, WILLIAM D	
		ART UNIT	PAPER NUMBER	2683

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/617,074	SCOTT PREECE	
	Examiner WILLIAM D. CUMMING	Art Unit 2683	

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 August 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8 and 15-26 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 21-26 is/are allowed.  
 6) Claim(s) 1-8 and 15-20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 10 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 7/10/03.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the location system independent of the communication system as stated by claim 5 and location broadcasting network access points as stated by claim 8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
  
2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-8 and 15-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to provide an enabling disclosure on how a user with a radio telephone is in a no-coverage area, meaning that the radio telephone system (the last known) and the radio telephone can not communicate, can obtain any service from the radio telephone system, especially the last known, since the radio telephone is still in the no-coverage area of that radio telephone

system, as stated in claims 1, 9, and 15. Returning the radio telephone to the coverage area to obtain service is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The radio telephone or user never obtains service when in a no-coverage area according to the specification. The specification states when a user is in a no-coverage area, the radio telephone informs the user how to get back to the coverage area to obtain service. Once back in the coverage area, the user and radio telephone obtains service.

6. Claims 5 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification inadequately describe the location system independent of the communication system as stated by claim 5 and location broadcasting network access points as stated by claim 8. The "*written description*" of the invention required by first paragraph of 35 USC §112 is separate and distinct from that paragraph's requirement of enabling disclosure, since description must do more than merely provide explanation of how to "*make and use*" the invention. Applicant must also convey, with reasonable clarity to those skilled in the art, that

applicant, as of the filing date sought, was in possession of the invention, with the invention being, for purpose of "*written description*" inquiry, whatever is presently claimed. Drawings alone may, under proper circumstances, provide "*written description*" of the invention required by 35 USC §112, and whether the drawings are from design application or utility application is not determinative. In order to satisfy "*written description*" requirement of 35 USC §112, the proper test is whether drawings conveys, with reasonable clarity to those of ordinary skill in the art, the claim subject matter.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-8 and 15-20, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 9, and 15, these claims are confusing since obtaining service from a no-coverage area of a radiotelephone communication system. By definition a no coverage area does not have any service. If the radio telephone can receive service, by definition, it cannot be a no service area.

Regarding claims 7 and 20, the term "*a communication system*" is confusing since is there a third type of communication system now, the "*too far away*" communication system?

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1-8 and 15-20 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. It is impossible to obtain service from a no-coverage area of a radiotelephone communication system since by definition a no coverage area does not have any service. If the radio telephone can receive service, by definition, it cannot be a no service area.

***Response to Amendment***

**11. Updated Lists of Exceptions to the Centralized Delivery and Facsimile Transmission Policy for Patent Related Correspondence**

The United States Patent and Trademark Office (Office) requires most patent related correspondence to be: a) faxed to the Central FAX number (571-273-8300), b) hand carried or delivered to the Customer Service Window (located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), c) mailed to the mailing address set forth in 37 CFR 1.1 (e.g., P.O. Box 1450, Alexandria, VA 22313-1450), or d) transmitted to the Office using the Office's Electronic Filing System.

General "Centralized Delivery" Policy: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window unless an exception under List I of this notice applies, and facsimile transmissions must be sent to the Central FAX number (571-273-8300) unless an exception under List II of this notice applies. Exceptions to the general policy of "centralized delivery" generally involve situations where special handling of the patent related correspondence is available. All the current exceptions are listed in this notice. Correspondence which is not related to a specific patent or patent application, such as a question on policy, on employment, or other general inquiry, is not covered by this notice.

Updated Lists of Exceptions: This notice replaces all prior Office notices specifying a fax number or hand carry address for certain patent related correspondence. Five significant updates have occurred to the lists of exceptions since they were last published on July 12, 2005. The five updated items are as follows:

(1) the Office of Public Records exceptions at the end of Lists I and II have been added.

(2) the PCT Operations facsimile number for correspondence permitted to be filed by facsimile in international applications under List II, exception 1, has changed to 571-273-3201.

(3) the Office of Patent Publication facsimile number under List II, exception 2, has changed to 571-273-2885, and the local area telephone number to check on receipt of payments transmitted by facsimile under that exception has changed to 571-272-4200.

(4) the Assignment Branch facsimile number under List II, exception 5, has changed to 571-273-0140.

(5) the Central Reexamination Unit (CRU) facsimile number under List II, exception 6, has changed to 571-273-9900.

In addition to updating the five items above, this notice corrects an error in the information last published for List I, exception 11, to reflect that the Office of Enrollment and Discipline delivery location is in the Madison West building - not the Madison East building.

List I – Exceptions for Certain Hand Carried Correspondence

Current exceptions: Only the following types of correspondence may be delivered (hand-carried) to the specific location provided below instead of the Customer Service Window.

If correspondence listed below is carried to the Customer Service Window, the correspondence will be accepted and routed to the appropriate office.

1. Access Requests: Requests for access to patent application files may continue to be hand carried to the File Information Unit (FIU) in Room 2E04, 2900 Crystal Drive (South Tower), Arlington VA 22202. Requests for access to patent application files that are maintained in the Image File Wrapper system and that have not yet been published may also be hand carried to the Public Search

Facility on the 1<sup>st</sup> floor of the Madison East building, 600 Dulany Street, Alexandria VA 22314.

2. Patent Term Extensions under 35 U.S.C. § 156: Patent term extension applications under 35 U.S.C. 156 (Hatch/Waxman) may be hand-carried to the Office of Patent Legal Administration (OPLA) in Room 7D85, 600 Dulany Street (Madison West building), Alexandria VA 22314. At the guard station in Madison West (near the elevators), the security guard should call the OPLA at either 571-272-7701 or 571-272-7746 for delivery assistance.

3. Assignments to be Recorded: Assignments may be hand-carried to the Office of Public Records Customer Service Window on the 2nd floor of the South Tower building, 2900 Crystal Drive, Arlington VA 22202.

4. Office of General Counsel: Correspondence for the Office of General Counsel may be hand-carried to the Office of General Counsel in Room 10C20, 600 Dulany Street (Madison East building), Alexandria VA 22314. At the guard station in Madison East (near the elevators), the security guard should call the Office of General Counsel at 571-272-7000 for delivery assistance.

5. Solicitor's Office: Correspondence for the Solicitor's Office may be hand-carried to the Solicitor's Office in Room 8C43-A, 600 Dulany Street (Madison West

building), Alexandria VA 22314. At the guard station in Madison West (near the elevators), the security guard should call the Solicitor's Office at 571-272-9035 for delivery assistance.

6. Interference related correspondence: Correspondence relating to interferences may be hand-carried to the 1<sup>st</sup> floor lobby of Madison East building, 600 Dulany Street, Alexandria VA 22314, where a drop-off box for hand-carried documents to be filed with the Board of Patent Appeals and Interferences is located. Customers need to pass through the magnetometer and have the materials passed through the x-ray sensors before placing them in the drop-off box. The drop-off box is for Interference related correspondence ONLY. Boxes are not permitted in the drop-off box. Boxed materials should be hand-carried to Madison East, Room 9B55-A using the following procedures. At the first floor guard station in Madison East (near the elevators), the security guard should call the Board of Patent Appeals and Interferences at 571-272-9797 to obtain authorization to allow entry into the building for delivery to Room 9B55-A. Access to Room 9B55-A is available on business days from 8:30 a.m to 4:45 p.m. only. Documents/boxes hand-carried to the drop-off box or to Room 9B55-A after 4:45 p.m. (EST) will receive the next business day's filing date.

Customers desiring a stamped return receipt for their filing need to personally bring their filing and postcard to Room 9B55-A during the hours stated above, or leave the postcard with the filing (postcard must include correct postage mail stamp and the address where the postcard it to be mailed). The Board will stamp the filing date and mail the postcard to the customer.

7. Secrecy Order: Applications subject to a secrecy order pursuant to 35 U.S.C. 181, or which are national security classified, and correspondence related thereto, may be hand-carried to the Licensing and Review location. See 37 CFR §§ 5.1(c) and 5.2(c). The Licensing and Review location is: Technology Center 3600, Room 4B31, 501 Dulany Street (Knox building), Alexandria VA 22314. At the guard station in Knox (near the elevators), the security guard should call Licensing and Review at 571-272-8203 for delivery assistance.

8. Expedited Foreign Filing License Petitions: Petitions for a foreign filing license pursuant to 37 CFR 5.12(b) for which expedited handling is requested and petitions for a retroactive license under 37 CFR 5.25, may be hand-carried to the drop box located at the guard station in the Knox building. Upon approaching the guard station, the delivery personnel should state their desire to drop off the request. Correspondence packages will be inspected/scanned before being placed in the drop box. All requests should identify a fax number, telephone number and mailing address. All responses to the request will be sent by fax, followed by a mailed copy. If a fax number is not available, a hardcopy will be mailed to the mailing address provided.

9. Petitions to Withdraw from Issue: Petitions to Withdraw from Issue may be hand carried to the Office of Petitions on the 7<sup>th</sup> floor of the Madison West building, 600 Dulany Street, Alexandria VA 22314. At the guard station in Madison West (near the elevators), the security guard should call the Office of Petitions at 571-272-3282 for

delivery assistance. Hand carried papers will be accepted on business days between the hours of 8:30 a.m. until 3:45 p.m.

10. Documents requested by the Office of Patent Publication: Documents requested by the Office of Patent Publication may be hand carried to the Office of Patent Publication in Room 8A24, 2900 Crystal Drive (South Tower building), Arlington VA 22202, during business hours.

11. Office of Enrollment and Discipline (OED): Correspondence for the Office of Enrollment and Discipline may be hand carried to the receptionist at Room 8C43-B, 600 Dulany Street (Madison West building), Alexandria VA 22314. At the guard station in Madison West (near the elevators), the security guard should call the Office of Enrollment and Discipline at 571-272-4097 for delivery assistance.

12. Office of Finance: Refund requests, deposit account replenishments, and maintenance fee payments may be hand-carried to the Office of Finance receptionist in Suite 300, 2051 Jamieson Avenue (Carlyle Place building), Alexandria, VA 22314. Hand-carried correspondence will only be accepted, and not processed. Although the receptionist will not process any correspondence, if the correspondence is delivered with an itemized postcard, the receptionist will provide a delivery receipt by date stamping the postcard. Depending on whether the correspondence is a refund request, deposit account related (e.g., a deposit account replenishment), or maintenance fee related (e.g., a maintenance fee payment), the correspondence should be placed in an envelope with REFUND, DEPOSIT ACCOUNT, or MAINTENANCE FEE written in dark ink across the envelope.

13. Office of Public Records: Requests for certified copies of Office records including patent and trademark copies, applications-as-filed, file wrappers and contents, and assignment records may be hand-carried to the Office of Public Records' Customer Service Window on the 2<sup>nd</sup> floor of the South Tower building, 2900 Crystal Drive, Arlington, VA 22202, during business hours.<sup>ii</sup>

List II - Exceptions for Certain Facsimile Transmitted Correspondence

For each Office location listed below, only the particular type of correspondence indicated may be transmitted to the specific facsimile number at that Office location. All other types of facsimile transmitted correspondence must be sent to the Central FAX number (571-273-8300).

1. PCT Operations and PCT Legal Administration

Correspondence subsequent to filing in an international application before the U.S. Receiving Office, the U.S. International Searching Authority, or the U.S. International Examining Authority:<sup>ii</sup>

Papers in international applications: 571-273-3201 facsimile number

Response to Decisions on Petition: 571-273-0459 facsimile number

Note: An international application for patent or a copy of the international application and the basic national fee necessary to enter the national stage, as specified in 37 CFR 1.495(b), may NOT be submitted by facsimile. See 37 CFR 1.6(d)(3) (referencing 37 CFR 1.8(a)(2)(i)(D) and (F)). Subsequent correspondence may be transmitted by facsimile in an application before the U.S. Receiving Office, the U.S. International

Searching Authority, or the U.S. International Examining Authority, but it will NOT receive the benefit of any certificate of transmission (or mailing). See 37 CFR 1.8(a)(2) (i)(E). Correspondence during national stage, subsequent to entry, are handled in the same manner as a U.S. national application.

The PCT Help Desk: 571-273-0419 facsimile number  
571-272-4300 telephone number

#### 2. Office of Patent Publication

Payment of an issue fee and any required publication fee by authorization to charge a deposit account or credit card, and drawings: 571-273-2885 facsimile number<sup>ii</sup>  
Note: Although submission of drawings by facsimile may reduce the quality of the drawings, the Office will generally print the drawings as received.  
Office of Patent Publication telephone numbers to check on receipt of payment:

571-272-4200<sup>ii</sup> or 1-888-786-0101

#### 3. Office of Pre-Grant Publication

Petitions for express abandonment to avoid publication under 37 CFR 1.138(c), and Requests for express abandonment under 37 CFR 1.138: 703-305-8568 facsimile number

Pre-Grant Publication Division telephone number for questions relating to the publication of patent applications: 703-605-4283. Questions may also be directed by e-mail to pgpub@uspto.gov.

#### 4. Electronic Business Center (EBC)

Requests for Customer Number Data Change (PTO/SB/124), and Requests for a Customer Number (PTO/SB/125): 571-273-0177 facsimile number

Note: The EBC may also be reached by e-mail at: ebc@uspto.gov.

EBC telephone number for customer service and assistance: 866-217-9197

#### 5. Assignment Branch

Assignments or other documents affecting title: 571-273-0140 facsimile number<sup>ii</sup>  
Note: Customers may submit documents directly into the automated Patent and Trademark Assignment System and receive the resulting recordation notice at their facsimile machine. (Assignment documents submitted through the Electronic Patent Assignment System also permits the recordation notice to be faxed to customers.) Credit card payments to record assignment documents are now accepted, and use of the Credit Card form (PTO-2038) is required for the credit card information to be separated from the assignment records. Only documents with an identified patent application or patent number, a single cover sheet to record a single type of transaction, and the fee paid by an authorization to charge a USPTO deposit account or credit card may be submitted via facsimile. Please refer to the USPTO Web Site, at <http://www.uspto.gov/web/offices/ac/ido/opr/ptasfax.pdf> for more information regarding the submission of assignment documents via facsimile.

Assignment Branch telephone number for assistance: 571-272-3350<sup>ii</sup>

#### 6. Central Reexamination Unit (CRU)

*Ex parte* and *Inter partes* reexamination correspondence, except for the initial request:

571-273-9900 facsimile number <sup>ii</sup> Note: Correspondence related to reexamination proceedings will be separately scanned in the CRU.

CRU telephone number for customer service and inquiries: 571-272-7705

**7. Board of Patent Appeals and Interferences**

Correspondence related to pending interferences permitted to be transmitted by facsimile (only where expressly authorized, see 37 CFR 1.6(d)(9)): 571-273-0042 facsimile number

Note: Correspondence should not be transmitted to this number if an interference has not yet been declared.

**8. Office of the General Counsel**

Correspondence permitted to be transmitted to the Office of General Counsel: 571-273-0099 facsimile number

**9. Office of the Solicitor**

Correspondence permitted to be transmitted by facsimile to the Office of the Solicitor: 571-273-0373 facsimile number

**10. Licensing and Review**

Petitions for a foreign filing license pursuant to 37 CFR 5.12(b), including a petition for a foreign filing license where there is no corresponding U.S. application (37 CFR 5.13): 571-273-0185 facsimile number

Note: Correspondence to be filed in a patent application subject to a secrecy order under 37 CFR Sec. 5.1 through 5.5 and directly related to the secrecy order content of the application may NOT be transmitted via facsimile. See 37 CFR Sec. 1.6(d)(6).

**11. Office of Petitions**

Petitions to Withdraw from Issue: 571-273-0025 facsimile number

Note: All other types of petitions must be directed to the Central FAX Number (571-273-8300). Petitions to Withdraw from Issue sent to the Central FAX Number should be marked "Special Processing Submission".

**12. Office of the Enrollment and Discipline**

Correspondence permitted to be transmitted to the Office of Enrollment and Discipline: 571-273-0074 facsimile number

**13. Office of Finance**

Refund requests, deposit account inquiries, and maintenance fee payments: 571-273-6500 facsimile number

Office of Finance telephone number for customer service and inquiries: 571-272-6500

**14. Office of Public Records**

Requests for certified copies of Office records may be transmitted to: 571-273-3250 <sup>ii</sup> facsimile number.

The Office of Public Records' Document Services Division telephone number for customer service and inquiries: 571-272-3150. <sup>ii</sup>

**FOR FURTHER INFORMATION CONTACT:**

Inquiries concerning receipt and status of specific correspondence should continue to be directed to the appropriate office that considers the correspondence on the merits.

Please allow sufficient time for the correspondence to be scanned into the IFW system or to be forwarded to the appropriate location before contacting the Office. Applicants may electronically verify the receipt and status of the correspondence using the private side of the Patent Application Information Retrieval (PAIR) system and are strongly encouraged to make use of this PAIR capability. Information related to both the private and public sides of PAIR can be found on the Office website at <http://www.uspto.gov/ebc/pair/help.html>.

Questions related to PAIR or the Office's facsimile system should be directed to the Electronic Business Center at 866-217-9197 (toll-free) or 571-272-4100.

9/19/2005 /S/

***Allowable Subject Matter***

12. Claims 21-26 are allowed.
  
13. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

***Response to Arguments***

14. Applicant's arguments filed August 29, 2005 have been fully considered but they are not persuasive.

Applicant's state that he has submitted drawings correction, but no such drawing correction can be found.

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The

standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

Determining enablement is a question of law based on underlying factual findings. *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir.

1991); *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984).

Before any analysis of enablement can occur, it is necessary for the examiner to construe the claims. For terms that are not well-known in the art, or for terms that could have more than one meaning, it is necessary that the examiner select the definition that he/she intends to use when examining the application, based on his/her understanding of what applicant intends it to mean, and explicitly set forth the meaning of the term and the scope of the claim when writing an Office action. See *Genentech v. Wellcome Foundation*, 29 F.3d 1555, 1563-64, 31 USPQ2d 1161, 1167-68 (Fed. Cir. 1994).

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of **35 U.S.C. 112**, first paragraph, unless there is a reason to doubt the objective truth of the

statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." 439 F.2d at 224, 169 USPQ at 370.

According to *In re Bowen*, 492 F.2d 859, 862-63, 181 USPQ 48, 51 (CCPA 1974), the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement. This standard is applicable even when there is no evidence in the record of operability without undue experimentation beyond the disclosed embodiments. See also *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995) (citing *In re Bundy*, 642 F.2d 430, 433, 209 USPQ 48, 51 (CCPA 1981)) (discussed in MPEP § 2164.07 regarding the relationship of the enablement requirement to the utility requirement of 35 U.S.C. 101).

While the analysis and conclusion of a lack of enablement are based on the factors discussed in MPEP § 2164.01(a) and the evidence as a whole, it is not necessary to discuss each factor in the written enablement rejection. The language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. This can be done by making specific findings of fact, supported by the evidence, and then drawing conclusions based on these findings of fact. For example, doubt may arise about enablement because information is missing about one or more essential parts or relationships between parts which one skilled in the art could not develop without undue experimentation. In such a case, the examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation. See MPEP § 2164.06(a). References should be supplied if possible to support a *prima facie* case of lack of enablement, but are not always required. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). However, specific technical reasons are always required.

Once the examiner has weighed all the evidence and established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on applicant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the application as a guide. *In re Brandstadter*, 484 F.2d 1395, 1406-07, 179 USPQ 286, 294 (CCPA 1973). The evidence provided by applicant need not be conclusive but merely convincing to one skilled in the art.

Applicant may submit factual affidavits under 37 CFR 1.132 or cite references to show what one skilled in the art knew at the time of filing the application. A declaration or affidavit is, itself, evidence that must be considered. The weight to give a declaration or affidavit will depend upon the amount of factual evidence the declaration or affidavit contains to support the conclusion of enablement. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991) ("expert's opinion on the ultimate legal conclusion must be supported by something more than a conclusory statement"); cf. *In re Alton*, 76 F.3d 1168, 1174, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996) (declarations relating to the written description requirement should have been considered).

Applicant should be encouraged to provide any evidence to demonstrate that the disclosure enables the claimed invention. Once that evidence is submitted, it must be weighed with all other evidence according to the standards set forth above so as to reach a determination as to whether the disclosure enables the claimed invention. Applicant's attorney failed to provide any evidence.

To overcome a *prima facie* case of lack of enablement, applicant must demonstrate by argument and/or evidence that the disclosure, as filed, would have enabled the claimed invention for one skilled in the art at the time of filing. This does not preclude applicant from providing a declaration after the filing date which demonstrates that the claimed invention works. However, the examiner should carefully compare the steps, materials, and conditions used in the experiments of the declaration with those disclosed in the application to make sure that they are commensurate in scope; i.e., that the experiments used the guidance in the specification as filed and what was well known to one of skill in the art. Such a showing also must be commensurate with the scope of the claimed invention, i.e., must bear a reasonable correlation to the scope of the claimed invention.

The examiner must then weigh all the evidence before him or her, including the specification and any new evidence supplied by applicant with the evidence and/or sound scientific reasoning previously presented in the rejection and decide whether the claimed invention is enabled. The determination should always be based on the weight of all the evidence.

Whether the specification would have been enabling as of the filing date involves consideration of the nature of the invention, the state of the prior art, and the level of skill in the art. The initial inquiry is into the nature of the invention, i.e., the subject matter to which the claimed invention pertains. The nature of the invention becomes the backdrop to determine the state of the art and the level of skill possessed by one skilled in the art.

The state of the prior art is what one skilled in the art would have known, at the time the application was filed, about the subject matter to which the claimed invention pertains. The relative skill of those in the art refers to the skill of those in the art in relation to the subject matter to which the claimed invention pertains at the time the application was filed.

See MPEP § 2164.05(b).

The state of the prior art provides evidence for the degree of predictability in the art and is related to the amount of direction or guidance needed in the specification as filed to meet the enablement requirement. The state of the prior art is also related to the need for working examples in the specification.

The state of the art for a given technology is not static in time. It is entirely possible that a disclosure filed on January 2, 1990, would not have been enabled. However, if the same disclosure had been filed on January 2, 1996, it might have enabled the claims. Therefore, the state of the prior art must be evaluated for each application based on its filing date.

**35 U.S.C. 112** requires the specification to be enabling only to a person "*skilled in the art to which it pertains, or with which it is most nearly connected.*" In general, the pertinent art should be defined in terms of the problem to be solved rather than in terms of the technology area, industry, trade, etc. for which the invention is used.

The specification need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known to those skilled and already available to the public. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and *Lindemann*

*Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

The state of the art existing at the filing date of the application is used to determine whether a particular disclosure is enabling as of the filing date. >*Chiron Corp. v. Genentech Inc.*, 363 F.3d 1247, 1254, 70 USPQ2d 1321, 1325-26 (Fed. Cir. 2004) ("a patent document cannot enable technology that arises after the date of application").< Publications dated after the filing date providing information publicly first disclosed after the filing date generally cannot be used to show what was known at the time of filing. *In re Gunn*, 537 F.2d 1123, 1128, 190 USPQ 402,405-06 (CCPA 1976); *In re Budnick*, 537 F.2d 535, 538, 190 USPQ 422, 424 (CCPA 1976) (In general, if an applicant seeks to use a patent to prove the state of the art for the purpose of the enablement requirement, the patent must have an issue date earlier than the effective filing date of the application.). While a later dated publication cannot supplement an insufficient disclosure in a prior dated application to make it enabling, applicant can offer the testimony of an expert based on the publication as evidence of the level of skill in the art at the time the application was filed. *Gould v. Quigg*, 822 F.2d 1074, 1077, 3 USPQ2d 1302, 1304 (Fed. Cir. 1987).

In general, the examiner should not use post-filing date references to demonstrate that the patent is non-enabling. Exceptions to this rule could occur if a later-dated reference provides evidence of what one skilled in the art would have known on or before the effective filing date of the patent application. *In re Hogan*, 559 F.2d 595, 605, 194 USPQ 527, 537 (CCPA 1977). If individuals of skill in the art state that a particular invention is not possible years after the filing date, that would be evidence that the disclosed invention was not possible at the time of filing and should be considered. In *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513-14 (Fed. Cir. 1993) an article published 5 years after the filing date of the application adequately supported the examiner's position that the physiological activity of certain viruses was sufficiently unpredictable so that a person skilled in the art would not have believed that the success with one virus and one animal could be extrapolated successfully to all viruses with all living organisms. Claims not directed to the specific virus and the specific animal were held nonenabled.

Applicant's attorney remarks seems to the examiner that one person wrote the specification, one person wrote the claims and another person wrote the arguments and all these persons did not even read each other works at all. The claims clearly read:

*"A method for obtaining service when in a no-coverage area of a radiotelephone communication system, the method comprising the steps of: storing information regarding a last known available communication system; reporting the information about the last known available communication system to a user of the radiotelephone; and using the information to obtain service from the last known available communication system."*

Applicant's attorney has still has not explain how "when in a no-coverage area of a radiotelephone communication system" and then "obtain service from the last known available communication system."

The "*written description*" of the invention required by first paragraph of 35 USC §112 is separate and distinct from that paragraph's requirement of enabling disclosure, since description must do more than merely provide explanation of how to "*make and use*" the invention. Applicant must also convey, with reasonable clarity to those skilled in the art, that applicant, as of the filing date sought, was in possession of the invention, with the invention being, for purpose of "*written description*" inquiry, whatever is presently claimed. Drawings alone may, under proper circumstances, provide "*written description*" of the invention required by 35 USC §112, and whether the drawings are from design application or utility application is not determinative. In order to satisfy "*written description*" requirement of 35 USC §112, the proper test is whether drawings conveys, with reasonable clarity to those of ordinary skill in the art, the claim subject matter.

An invention that is "inoperative" (i.e., it does not operate to produce the results claimed by the patent applicant) is not a "useful" invention in the meaning of the patent law. See, e.g., *Newman v. Quigg*, 877 F.2d 1575, 1581, 11 USPQ2d 1340, 1345 (Fed. Cir. 1989); *In re Harwood*, 390 F.2d 985, 989, 156 USPQ 673, 676 (CCPA 1968) ("An inoperative invention, of course, does not satisfy the requirement of 35 U.S.C. 101 that an invention be useful."). However, as the Federal Circuit has stated, "[t]o violate [35 U.S.C.] 101 the claimed device must be totally incapable of achieving a useful result." *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992) (emphasis added). See also *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980)

Situations where an invention is found to be "inoperative" and therefore lacking in utility are rare, and rejections maintained solely on this ground by a Federal court even rarer. In many of these cases, the utility asserted by the applicant was thought to be "incredible in the light of the knowledge of the art, or factually misleading" when initially considered by the Office. *In re Citron*, 325 F.2d 248, 253, 139 USPQ 516, 520 (CCPA 1963). Other cases suggest that on initial evaluation, the Office considered the asserted utility to be inconsistent with known scientific principles or "speculative at best" as to whether attributes of the invention

necessary to impart the asserted utility were actually present in the invention. *In re Sichert*, 566 F.2d 1154, 196 USPQ 209 (CCPA 1977). However cast, the underlying finding by the court in these cases was that, based on the factual record of the case, it was clear that the invention could not and did not work as the inventor claimed it did.

A deficiency under **35 U.S.C. 101** also creates a deficiency under **35 U.S.C. 112**, first paragraph. See *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995); *In re Jolles*, 628 F.2d 1322, 1326 n.10, 206 USPQ 885, 889 n.11 (CCPA 1980); *In re Fouche*, 439 F.2d 1237, 1243, 169 USPQ 429, 434 (CCPA 1971) ("If such compositions are in fact useless, appellant's specification cannot have taught how to use them."). Courts have also cast the **35 U.S.C. 101/ 35 U.S.C. 112** relationship such that **35 U.S.C. 112** presupposes compliance with **35 U.S.C. 101**. See *In re Ziegler*, 992 F.2d 1197, 1200-1201, 26 USPQ2d 1600, 1603 (Fed. Cir. 1993) ("The how to use prong of section 112 incorporates as a matter of law the requirement of **35 U.S.C. 101** that the specification disclose as a matter of fact a practical utility for the invention. ... If the application fails as a matter of fact to satisfy **35 U.S.C. § 101**, then the application also fails as a matter of law to enable one of ordinary skill in the art to use the invention under **35 U.S.C. § 112**."); *In re Kirk*, 376 F.2d 936, 942, 153 USPQ 48, 53 (CCPA 1967) ("Necessarily, compliance with § 112 requires a description of how to use presently useful inventions, otherwise an

applicant would anomalously be required to teach how to use a useless invention."). For example, the Federal Circuit noted, "[o]bviously, if a claimed invention does not have utility, the specification cannot enable one to use it." *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995). As such, a rejection properly imposed under **35 U.S.C. 101** should be accompanied with a rejection under **35 U.S.C. 112**, first paragraph. It is equally clear that a rejection based on "lack of utility," whether grounded upon **35 U.S.C. 101** or **35 U.S.C. 112**, first paragraph, rests on the same basis (i.e., the asserted utility is not credible). To avoid confusion, any rejection that is imposed on the basis of **35 U.S.C. 101** should be accompanied by a rejection based on **35 U.S.C. 112**, first paragraph. The **35 U.S.C. 112**, first paragraph, rejection should be set out as a separate rejection that incorporates by reference the factual basis and conclusions set forth in the **35 U.S.C. 101** rejection. The **35 U.S.C. 112**, first paragraph, rejection should indicate that because the invention as claimed does not have utility, a person skilled in the art would not be able to use the invention as claimed, and as such, the claim is defective under **35 U.S.C. 112**, first paragraph. A **35 U.S.C. 112**, first paragraph, rejection should not be imposed or maintained unless an appropriate basis exists for imposing a rejection under **35 U.S.C. 101**. In other words, Office personnel should not impose a **35 U.S.C. 112**, first paragraph, rejection grounded on a "lack of utility" basis unless a **35 U.S.C. 101** rejection is

proper. In particular, the factual showing needed to impose a rejection under **35 U.S.C. 101** must be provided if a rejection under **35 U.S.C. 112**, first paragraph, is to be imposed on "lack of utility" grounds.

It is important to recognize that **35 U.S.C. 112**, first paragraph, addresses matters other than those related to the question of whether or not an invention lacks utility. These matters include whether the claims are fully supported by the disclosure (*In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991)), whether the applicant has provided an enabling disclosure of the claimed subject matter (*In re Wright*, 999 F.2d 1557, 1561-1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)), whether the applicant has provided an adequate written description of the invention and whether the applicant has disclosed the best mode of practicing the claimed invention (*Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 927-928, 16 USPQ2d 1033, 1036-1037 (Fed. Cir. 1990)). See also *Transco Products Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994); *Giloxo Inc. v. Novopharm Ltd.* 52 F.3d 1043, 34 USPQ2d 1565 (Fed. Cir. 1995). The fact that an applicant has disclosed a specific utility for an invention and provided a credible basis supporting that specific utility does not provide a basis for concluding that the claims comply with all the requirements of **35 U.S.C. 112**, first paragraph. For example, if an applicant has claimed a process of treating a certain disease condition with a certain compound and provided a

credible basis for asserting that the compound is useful in that regard, but to actually practice the invention as claimed a person skilled in the relevant art would have to engage in an undue amount of experimentation, the claim may be defective under 35 U.S.C. 112, but not 35 U.S.C. 101. To avoid confusion during examination, any rejection under 35 U.S.C. 112, first paragraph, based on grounds other than "lack of utility" should be imposed separately from any rejection imposed due to "lack of utility" under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
  
16. **A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.**

## **17. New Pre-Appeal Brief Conference Pilot Program**

This new program offers applicants an avenue to request that a panel of examiners formally review the legal and factual basis of the rejections in their application prior to the filing of an appeal brief. Effective immediately, the USPTO is offering applicants an optional procedure to review the examiner's rejection prior to the actual filing of an appeal brief. The program is intended to spare applicants the added time and expense of preparing an appeal brief if a panel review determines an application is not in condition for appeal. Although this procedure will not be appropriate in every appealed application, in the proper situations it can save both the resources of the applicant and the Office. Applicants continue to have available to them the normal practice and procedures already in effect under Part 41 of the Title 37 of the Code of Federal Regulations relating to appeals and practice before the Board of Patent Appeals and Interferences.

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#### **1. General Provisions:**

##### **. What is this program?**

Under the current practice every applicant whose claims have been twice rejected may appeal the examiner's decision to the Board of Patent Appeals and Interferences. To do so, the applicant first files a notice of appeal accompanied by the appropriate fee i within the appropriate time period ii. Within two months from the date of the filing of the notice of appeal, applicant must file an appeal brief accompanied by the appropriate fee iii. Applicants may buy extensions of time for filing the appeal brief.

This pilot program offers applicants an opportunity to request a review of identified matters on appeal employing an appeal conference currently employed in the Office, but prior to the filing of an appeal brief. The goals of the program are (1) to identify the presence or absence of clearly improper rejections based upon error(s) in facts, or (2) to identify the

omission or presence of essential elements required to establish a *prima facie* rejection.

. Who can use this program?

Any applicant who has filed a notice of appeal and who wants a panel of experienced examiners to perform a detailed review of appealable issues within a set period of time.

. How to decide if you should request this panel review?

If the applicant feels the rejections of record are clearly not proper and are without basis, then filing this request may result in a panel decision that eliminates the need to file an appeal brief. This should be based upon a clear legal or factual deficiency in the rejections rather than an interpretation of the claims or prior art teachings. The latter is more appropriate for the traditional appeal process currently employed by applicants.

. What happens during a panel review?

A panel of examiners (including the examiner of record) will consider the merits of each ground of rejection for which appeal has been requested and will issue a written decision as to the status of the application.

. When should you file an appeal brief or other correspondence?

This program is designed to allow applicants who think there is a clear deficiency in the *prima facie* case in support of a rejection to file the request at the same time that they file a notice of appeal. This affords the Office the best opportunity to ensure that applicant will promptly receive a decision on the request. If the request is filed with the notice of appeal, the period of time for filing the appeal brief will be the later of the two-month period set in 37 CFR 41.37(a) or one month from the mail date of the decision on the request.

. What actions will terminate the panel's review?

If applicant files any of the following responses after filing a request, but prior to a decision by the appointed panel of examiners assigned to conduct the review, the review process will end and a decision will not be made on the merits of the request:

- an appeal brief

- a request for continued examination (RCE)
- an after-final amendment
- an affidavit or other evidence
- an express abandonment

A request for the declaration of an interference will also result in an end to the review process. Applicant will be promptly notified by an Office communication of termination or of dismissal of the request. If any of the above-noted actions occur, the period for filing the appeal brief (if applicable) will be the later of the two-month period set in 37 CFR 41.37(a) or one month from the mail date of the decision on the request.

## 2. Conditions Necessary to Request a Panel Review:

- Applicant must file a notice of appeal in compliance with 37 CFR 41.31.
- Applicant must file the request with the filing of a notice of appeal and before the filing of an appeal brief. 1

## 3. Content of Request:

a. File the request and accompanying arguments in a separate paper entitled, "Pre-Appeal Brief Request for Review". A sample request form has been created and is available on the USPTO Internet Website, on the forms page, as PTO/SB/33.

b. In five (5) or less total pages, provide a succinct, concise and focused set of arguments for which the review is being requested.

c. File the request with the notice of appeal.

d. Address the notice of appeal and the request to

- Mail Stop AF
- Commissioner for Patents
- P.O. Box 1450
- Alexandria, VA 22313-1450

- Fax the notice of appeal and the request to the Central FAX Number (now 571 273-8300)

- Hand carry the notice of appeal and the request to the

USPTO Customer Service Window, ATTN: Mail Stop AF

Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

e. No after-final or proposed amendments may accompany the request. iv

A request that fails to comply with the above noted submission requirements may be dismissed.

4. Content of Remarks or Arguments:

The request should specify-

- . clear errors in the examiner's rejections; or
- . the examiner's omissions of one or more essential elements needed for a prima facie rejection.

For example, the request should concisely point out that a limitation is not met by a reference or the examiner failed to show proper motivation for making a modification in an obviousness rejection (35 U.S.C. 103).

Applicants are encouraged to refer to arguments already of record rather than repeating them in the request. This may be done by simply referring to a prior submission by paper number and the relevant portions thereof (e.g., see paper number 3 at pages 4 to 6). However, references such as "see the arguments of record" or "see paper number X" are not helpful and will just obfuscate the real issues for review.

The request may not be more than five (5) pages total and the remarks should be drafted with the expectation that for a clear error in fact or other deficiency, a long detailed explanation is not needed. Requests are limited to appealable, not petitionable matters.

Any actual issues lacking factual basis, including interpretations of the prior art teachings or claim scope as contrasted with clear error in facts, are appropriate for the traditional appeal process and submission of the appeal brief. For grounds where a clear issue on proper interpretation exists, applicant is advised to proceed to appeal with the timely filing of the appeal brief. This program is not intended to be, and is not, an alternative for filing an appeal.

5. USPTO Consideration of the Request:

Upon receipt of a properly filed request, a Technology Center Art Unit supervisor will designate a panel of examiners experienced in the field of

technology to review the applicant's remarks and the examiner's rejections. The panel will include at least a supervisor and the examiner of record. The applicant will not be permitted to attend the review and no interviews will be granted prior to issuance of the panel's decision.

The panel members will review the rejection(s) identified by applicant in the request. They will also review the application and the appropriate evidence in support of the rejections to the extent necessary. The panel will then decide if an issue for appeal is, in fact, present in the record. The Office should mail a decision within 45 days of receipt of a properly filed request.

#### 6. Format of Panel Decision:

After the review is complete, the Office will mail a decision on the status of the application. The decision will state one of the following:

- . Finding 1: The application remains under appeal because there is at least one actual issue for appeal.
- . Finding 2: Prosecution on the merits is reopened and an appropriate Office communication will follow in due course. In appropriate circumstances, a proposed amendment may accompany the panel's decision proposing changes that, if accepted, may result in an indication of allowability for the contested claim(s).
- . Finding 3: The application is allowed on the existing claims and prosecution remains closed.
- . Finding 4: The request fails to comply with the submission requirements and is dismissed.

The decision will summarize the status of the pending claims (still rejected, withdrawn rejections, objected to or allowable claims).

A decision by a pre-appeal brief conference panel to withdraw the rejections of any or all of the claims on appeal is not a decision by a panel of the Board of Patent Appeals and Interferences, and, as such, would not result in any patent term extension of adjustment under 35 U.S.C. Sec. 154(b) (37 CFR 1.701(a)(3) and 1.702(e)).

The decision will not contain any additional grounds of rejection or any restatement of previously made rejections. Such matters will be addressed, as appropriate, in the Examiner's Answer.

#### 7. Time Periods Before/After a Panel Decision:

- . The request must be filed with the filing of a notice of appeal and before the filing of the appeal brief. No extensions of time are available for filing the request for review.
- . The time period for filing an appeal brief will be reset to be one month from mailing of the decision on the request, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of the decision on the request or the receipt date of the notice of appeal, as applicable. To the extent that any existing USPTO rule is inconsistent with this pilot program, the rule is waived until regulations directed to pre-appeal brief conferences are promulgated, or the pilot program is ended. For example, if a request for a pre-appeal brief conference is filed with a notice of appeal, the time period set in 37 CFR 41.37(a)(1) is waived so that an appeal will not stand dismissed if an appeal brief is not filed within two months of the filing date of a notice of appeal, but is filed within one month of the decision on the request.

Applicant's period for filing the appeal brief or other appropriate response ends on the mailing date of a panel decision that indicates all claims are allowed or that prosecution is reopened.

#### **8. Administrative Matters:**

- . Applicants should ensure that requests are mailed or faxed with the notice of appeal to ensure timely filing. The request should contain a certificate of mailing or transmission under 37 CFR 1.8 and be listed on any postcard receipt (MPEP 503).
- . No supplemental requests or arguments will be accepted.
- . The notice of appeal fee is not refundable, even in the event of a decision favorable to applicant.
- . A request filed after the date of receipt of the notice of appeal will be dismissed as untimely.
- . This procedure does not affect petitions to invoke supervisory authority under 37 CFR 1.181 because such petitions address procedural matters, not appealable, matters.
- . Panel decisions will not be petitionable because a decision to maintain a rejection is subject to appeal.
- . A pre-appeal brief conference panel decision that the application remains under appeal is not final agency action for purposes of court review. An applicant dissatisfied with the result of the appeal conference must pursue the appeal before the Board of Patent Appeals and Interferences.

- . This process does not apply to reexamination proceedings.
- . Following a panel review under this pilot program, the examiner retains the option to reopen prosecution or to allow an application after the filing of an appeal brief. This unlikely situation might arise, for example, where new arguments or evidence are presented in the appeal brief.
- . This pilot program will run for at least six months from its effective date. The Office may extend, terminate, revise or otherwise take appropriate action after evaluating its effectiveness at the end of that period. If the program is to be made permanent, the Office will promulgate the appropriate changes to title 37 of the Code of Federal Regulations.

Please direct inquiries with respect to a pending request for a pre-appeal brief conference to the examiner to whom the patent application is assigned, or the examiner's immediate supervisor. Please direct comments and inquiries on this pilot program to Anton Fetting via email addressed to [anton.fetting@uspto.gov](mailto:anton.fetting@uspto.gov). You may also contact Mr. Fetting at (571) 272-7701.

June 20, 2005

**18. United States Postal Service Interruption and Emergency under 35 U.S.C.21(a)**

The United States Patent and Trademark Office (USPTO) is designating the interruption in service of the United States Postal Service (USPS) in the areas affected by Hurricane Katrina in Louisiana, Mississippi, Alabama, and Florida on August 28, 2005, as a postal service interruption and an emergency within the meaning of 35 U.S.C. § 21((a) and 37 CFR 1.10(i) and 2.195(e)). Postal services in Louisiana, Mississippi, Alabama, and Florida have been suspended intermittently since Sunday, August 28, 2005, due to Hurricane Katrina. To determine whether a post office has been closed or postal services have been suspended in a particular area due to Hurricane Katrina, contact the post office directly or visit the USPS's Web site at: <http://www.usps.gov>.

As soon as the USPTO receives further information from the USPS as to when postal services in the affected areas will be resumed, the USPTO will post updated information regarding this situation on the USPTO Web site (<http://www.uspto.gov>) and in the Official Gazette.

**19. United States Postal Service Interruption and Emergency under 35 U.S.C. 21(a)**

The United States Patent and Trademark Office (USPTO) is designating the interruption in service of the United States Postal Service (USPS) in the areas affected by Hurricane Rita in Louisiana and Texas on September 23, 2005, as a postal service interruption and an emergency within the meaning of 35 U.S.C. § 21(a) and 37 CFR 1.10(i) and 2.195(e).

Postal services in Louisiana and Texas have been suspended intermittently since Friday, September 23, 2005, due to Hurricane Rita. To determine whether a post office has been closed or postal services have been suspended in a particular area due to Hurricane Rita, contact the post office directly or visit the USPS's Web site at: <http://www.usps.gov>.

As soon as the USPTO receives further information from the USPS as to when postal services in the affected areas will be resumed, the USPTO will post updated information regarding this situation on the USPTO Web site (<http://www.uspto.gov>) and in the Official Gazette.

**Patent-Related Correspondence**

37 CFR 1.10(i) addresses interruptions or emergencies in USPS "Express Mail Post Office to Addressee" service that are designated by the Director for patent-related correspondence. Correspondence covered by 37 CFR 1.10 that would have been filed with the USPTO under 37 CFR 1.10 during this USPS service interruption, but which was not filed due to the USPS service interruption, should be filed promptly after the termination of the USPS service interruption with a petition in accordance with 37 CFR 1.10(i) using "Express Mail" service in accordance with 37 CFR 1.10.

The provisions of 35 U.S.C. § 21(a) and 37 CFR 1.10(i) apply only to postal interruptions and emergencies. The provisions of 35 U.S.C. § 21(a) and 37 CFR 1.10(i) do not provide for the granting of a filing date to correspondence as of the date on which it would have been filed but for other exigencies, such as the unavailability of an office or building other than a USPS facility. These provisions apply only if the post office was closed or "Express Mail" service suspended in the affected areas on the specified date due to Hurricane Rita.

37 CFR 1.10(i) provides that any person attempting to file correspondence by "Express Mail Post Office to Addressee" service that was unable to be deposited with the USPS due to an interruption or emergency in "Express Mail" service which has been so designated by the Director may petition the Director to consider such correspondence as filed on a particular date in the Office. 37 CFR 1.10(i) specifically provides that: any person attempting to file correspondence under this section that was unable to be deposited with the USPS due to an interruption or emergency in "Express Mail" service which has been so designated by the Director, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

- (1) the petition is filed in a manner designated by the Director promptly after the person becomes aware of the designated interruption or emergency in "Express Mail" service;

(2) the petition includes the original correspondence or a copy of the original correspondence; and

(3) the petition includes a statement which establishes, to the satisfaction of the Director, that the correspondence would have been deposited with the USPS but for the designated interruption or emergency in "Express Mail" service, and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date.

Patent-related inquiries concerning this notice may be directed to Eugenia Jones, Senior Legal Advisor in the Office of Patent Legal Administration, at (571) 272-7704 or at PatentPractice@uspto.gov.

#### Trademark-Related Correspondence

37 CFR 2.195(e) and 2.198 address interruptions or emergencies in USPS "Express Mail Post Office to Addressee" service that are designated by the Director for trademark-related correspondence. Correspondence covered by 37 CFR 2.198 that would have been filed with the USPTO under 37 CFR 2.198 during this USPS service interruption, but which was not filed due to the USPS service interruption, should be filed promptly after the termination of the USPS service interruption with a petition in accordance with 37 CFR 2.146 and 2.198.

The provisions of 35 U.S.C. § 21(a) and 37 CFR 2.195(e) apply only to postal interruptions and emergencies. These provisions do not provide for the granting of a filing date to correspondence as of the date on which it would have been filed but for other exigencies, such as the unavailability of an office or building other than a USPS facility. These provisions apply only if the post office was closed or "Express Mail" service suspended in the affected areas on the specified date due to Hurricane Rita.

Under 37 CFR 2.195(e) and 2.198, any person attempting to file correspondence by "Express Mail Post Office to Addressee" service that was unable to be deposited with the USPS due to the interruption or emergency in "Express Mail" service in the areas designated in this notice may petition the Director to consider such correspondence as filed on a particular date in the Office. The petition must:

(1) Be filed promptly after the ending of the designated interruption or emergency in "Express Mail" service;

(2) Include the original correspondence or a copy of the original correspondence; and

(3) Include a statement which establishes, to the satisfaction of the Director, that (1) the correspondence would have been deposited with the USPS but for the designated interruption or emergency in "Express Mail" service, and (2) the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date.

Please note that under 37 CFR 2.101(b)(2), 2.102(a)(2) and 2.198(a)(1), the Express Mail procedures cannot be used for the following types of correspondence: applications for registration of marks; amendments to allege use under 15 U.S.C. § 1051(c); statements of use under 15 U.S.C. § 1051(d); requests for extension of time to

file a statement of use under 15 U.S.C. § 1051(d); affidavits of continued use under 15 U.S.C. § 1058; renewal applications under 15 U.S.C. §1059; requests to change or correct addresses; combined filings under 15 U.S.C. §§ 1058 and 1059; combined affidavits or declarations under 15 U.S.C. §§ 1058 and 1065; responses to notices of irregularity under 37 CFR 7.14; requests for transformation under 37 CFR 7.31; notices of opposition to applications based on 15 U.S.C. § 1141f(a); and requests for extensions of time to oppose applications based on 15 U.S.C. § 1141f(a).

Moreover, 37 CFR 2.197 (certificate of mailing procedure) does not provide for according a filing date as of the date of deposit with the USPS. Therefore, it would be inappropriate to file a petition seeking a filing date as of the date of deposit of the types of correspondence listed in 37 CFR 2.101(b)(2), 2.102(a)(2) and 2.198(a)(1) as Express Mail, or as of the date on a certificate of mailing under 37 CFR 2.197.

Trademark-related inquiries concerning this notice may be directed to Mary Hannon, Office of the Deputy Commissioner for Trademark Examination Policy, at (571) 272-9569.

Date: 9/27/05 /S/

20. If applicants request an interview after this final rejection, prior to the interview, the intended purpose and content of the interview should be presented briefly, in writing.

Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration.

Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search will be denied.

21. If applicants wish to request for an interview, an "*Applicant Initiated Interview Request*" form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed "*Applicant Initiated Interview Request*" form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM D. CUMMING whose telephone number is 571-272-7861. The examiner can normally be reached on Monday-Thursday 11am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WILLIAM D. CUMMING  
Primary Examiner  
Art Unit 2683

Wdc



UNITED STATES  
PATENT AND  
TRADEMARK OFFICE

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William Cumming  
Primary Patent Examiner  
William.Cumming@uspto.gov